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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
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Paper No. 15  
BAC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Thomson Multimedia Inc., by change of name from  
Thomson Consumer Electronics, Inc.<sup>1</sup>

Serial No. 75/573,721

**Scott J. Stevens** of Woodard, Emhardt, Naughton, Moriarty &  
McNett for Thomson Multimedia Inc., by change of name from  
Thomson Consumer Electronics, Inc.

**M. Catherine Faint**, Trademark Examining Attorney, Law  
Office 103 (Daniel Vavonese, Acting Managing Attorney).

Before Simms, Chapman and Drost, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant has applied to register the mark GENIUS  
THEATRE on the Principal Register for "television receivers  
and integrated receiver decoders."<sup>2</sup>

Registration has been finally refused under Section  
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the

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<sup>1</sup> Applicant's change of name was recorded with the Assignment  
Branch of this Office at Reel 2222, Frame 0402.

<sup>2</sup> Application Serial No. 75/573,721, filed October 20, 1998. The  
application is based on applicant's assertion of a bona fide  
intention to use the mark in commerce. Applicant disclaimed the  
term "theatre."

ground that applicant's mark, if used on or in connection with its specified goods, would so resemble the mark GENIUS REMOTE, which is registered for "remote controller for television receivers,"<sup>3</sup> as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have briefed the issues before us. An oral hearing was not requested.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Food, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Before turning to the merits, we must address two evidentiary matters. Applicant discussed on page eight of its brief its list of several third-party registrations,

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<sup>3</sup> Registration No. 1,592,814, issued April 24, 1990 to Hitachi Sales Corporation of America, Inc.; Section 8 affidavit accepted, renewed. Registrant disclaimed the term "remote." The claimed date of first use is January 24, 1989.

all of which include either the word "remote" or the word "theater" or "theatre"<sup>4</sup>; and applicant also included with its brief two exhibits, which are photocopies of pages printed from the Internet (Exhibit A is a one-page printout from onecall.com website and Exhibit B is a three-page printout from Hitachi's website). The Examining Attorney objected to the additional evidence submitted with applicant's brief, and she requested that the evidence be excluded.

Exhibit B is essentially identical (except for font size) to the two-page printout from Hitachi's website included by a previous Examining Attorney with the Final Office action dated November 7, 2000. Thus, this material was already of record and applicant need not have resubmitted it.

The record in an application should be complete prior to the filing of an appeal, and additional evidence filed after appeal will be given no consideration by the Board. See Trademark Rule 2.142(d), and TBMP §1207.01. Inasmuch as applicant's discussion of several third-party registrations (contained within its brief), and Exhibit A

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<sup>4</sup> Informationally, mere lists of registrations are not sufficient to make them of record. The Board does not take judicial notice of registrations residing in the USPTO. See *In re Duofold Inc.* 184 USPQ 638 (TTAB 1974); and *In re F.C.F. Inc.*, 30 USPQ2d 1825 (TTAB 1994).

(attached to its brief) were first raised or filed after the appeal, and the Examining Attorney objected thereto, this additional argument and evidence is untimely pursuant to Trademark Rule 2.142(d). Accordingly, they have not been considered in making our decision.<sup>5</sup>

We now turn to the merits of the appeal. Considering first the respective goods, it is well settled that they need not be identical or even competitive to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB

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<sup>5</sup> Citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986), applicant argued that fairness dictates that the Board should consider applicant's evidence on learning-type universal remote controls; or alternatively, applicant requested that we take judicial notice "of the fact that learning-type remote controls are common and well-known in the industry" (reply brief, p. 2). In the Bed & Breakfast Registry case, the evidence in question involved excerpted stories from Nexis and applicant had offered the full stories. (The Court concluded that the Board's exclusion of the full stories was harmless error.) Applicant's request that we consider the untimely evidence is denied.

Applicant's alternative request for judicial notice is denied because we find it is not a kind of fact subject to judicial notice pursuant to Fed. R. Evid. 201. See also, TBMP §712.

We hasten to add that even if we considered the excluded evidence, it would not alter our decision.

1992); and *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590 (TTAB 1978).

Also, it has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods as identified in the application with the goods as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case applicant's "television receivers and integrated receiver decoders" and registrant's "remote controller for television receivers" are complementary, closely related products. The remote controls for television receivers are obviously used for the specific purpose of and in close conjunction with the television receivers. See *Data Packaging Corporation v. Morning Star, Inc.*, 212 USPQ 109 (TTAB 1981); and *Lexicon, Incorporated v. Lexicon Music, Inc.*, 225 USPQ 201 (TTAB 1985).

Moreover, the Examining Attorney submitted copies of several third-party registrations, which issued on the basis of use in commerce, to demonstrate the relationship

between the involved goods, by showing in each instance that a single entity has adopted a mark for television receivers (and decoders) and remote controls for same.

Third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nevertheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have probative value to the extent they suggest that the listed goods or services emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

Regarding the channels of trade and the purchasers, because the respective identifications include no restrictions, the Board must consider that the parties' respective goods could be offered and sold to the same classes of purchasers through all normal channels of trade for such goods. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, supra; and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). In fact, applicant acknowledged that while its goods are sold through "specialized or dedicated electronics stores, rather than mass merchant or discount stores," registrant's goods "although they *may*

*often be found in such specialized stores, are often marketed through discount mass merchants."* (Brief, p. 7.) (Emphasis added.)

Based on the record before us, we readily conclude that applicant's goods are related to registrant's goods.

Turning to the marks, when analyzing applicant's mark and the registered mark, it is not improper to give more weight to a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). The word GENIUS is the dominant portion of both marks. In comparing the marks GENIUS THEATRE and GENIUS REMOTE, there are obvious similarities between the marks in sound, appearance and meaning. The first word in the marks is identical, followed by a descriptive or generic term. Although the marks include the terms "THEATRE" and "REMOTE" respectively, these descriptive/generic designations hardly serve to distinguish the marks in any meaningful way. Moreover, it is the first part of a mark which is most likely to be impressed upon the mind of a purchaser and be remembered by

the purchaser. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).

Purchasers are unlikely to distinguish the marks based on the descriptive/generic second word, when the arbitrary initial word is identical in both marks. This is particularly true when considering the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. That is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

In this case, the connotation created by the marks GENIUS THEATRE and GENIUS REMOTE is essentially the same when used in relation to the respective goods, television receivers (with decoders) and remote controllers for television receivers. That is, both marks refer to the concept of a "genius" or someone or something with exceptional intellectual power. See *The Wella Corporation v. California Concept Corporation*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977). We do not agree with applicant that registrant's mark will suggest to consumers "some ability



to learn functionality and interoperability between components, a major characteristic of learning universal remote controls" whereas applicant's mark "does not bring to mind any existing product or product category." (Reply brief, p. 2.) We are not persuaded that the purchasing public will pay such close attention to the minor differences in the marks or that they will analyze the marks through the technical method suggested by applicant. See Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986).

The marks, when considered in their entirety, are similar in sound, appearance, and connotation, creating a similar commercial impression.

Even if purchasers specifically realize that there are some differences between the involved marks, they may believe that applicant's mark is simply a version of registrant's mark for a new product offered by registrant, with both serving to indicate origin in the same source.

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d

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1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc.,  
837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

**Decision:** The refusal to register under Section 2(d)  
is affirmed.